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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,195	03/29/2001	Timothy C. Loose	47079-00086	4522
30223	7590	01/10/2006	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/821,195	LOOSE ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 December 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

♦  
**In reply to the RCE filed December 9th, 2005.**

**This action is final**

**Claims 1-11 are pending.**

♦

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-09-2005 has been entered.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed; and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-3**, and **5-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Buzzese (EP 0789338).

Regarding claims **1, 2, 7, and 9**, Saffari teaches an electronic video wager system incorporating a video portion with reel game (Figure 3 & Col 1:33-55) that displays a plurality of symbols indicating a randomly selected outcome of a wagering game and a separate non-video-portion (522, 523, & Col 3:2-5). The video portion further contains an integrated touch screen display and player selectable indicia (Col 2:64-3:2) as well as permanent second indicia (522). Saffari however is silent regarding the implementation of the permanent indicia as player selectable indicia and the incorporation of a unitary touch screen across both the video and non-video portions of the display.

In a related application however Buzzese teaches the incorporation of a unitary touch screen (34) including permanent player selectable indicia (Figures 3-4 & Col 3:9-39). Wherein the unitary touch screen spans across both the immediately adjacent game outcome display (44) and non-game outcome portions of the display ("PLAY 1"). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the touch screen configuration of Buzzese as taught above into the video game machine with touch screen of Saffari in order to reduce the device manufacture cost as taught by Buzzese (Col 2:18-24).

Regarding claims **3, 5 and 6**, the elements (522) of Saffari may be considered to show the claimed permanent indicia. Alternatively however, Buzzese teaches the use of an adhesive graphic transfer to create a graphic display or artwork panel as so

claimed. Bruzzese further teaches the use of indicia including a "collect" indicia, to indication to the player touch points and their respective function of the artwork panel (Col 3:18-33 & Fig 3).

Regarding claim 8, Saffari teaches the alteration of the video based indicia based on the progress or state of the game as so claimed (Figure 3).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Bruzzese (EP 0789338) as applied to claims 1 and 3 above in further view of Bridgeman et al (US 5,033,744).

The invention of Saffari/Bruzzese is silent regarding the selective illumination of indicia through lights located behind the artwork panel in order to indicate which indicia are active and may be selected by the player. However in a related application Bridgeman teaches the use of illuminated mechanical switches in order to indicate to a player that a video gaming machine is ready to accept user input (Figure 2 & Col 5:68-6:2). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the use of illumination to indicate the availability of a switch to accept inputs as taught by Bridgeman into the portion of a touch screen located over artwork as taught by Saffari/Bruzzese in order to direct the user to game inputs only when said inputs are available.

[The section entitled Response to arguments below is incorporated herein with appropriate emphasis drawn to the redress of claims 4 and 11]

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Bruzzese (EP 0789338) as applied to claims 1 and 3 above in further view of Schneider et al (US 6,089,976).

The invention of Saffari/Bruzzese is silent regarding the displaying of a bonus outcome in response to a bonus outcome being achieved however Schneider teaches the displaying of a bonus game on a bonus outcome (Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate this feature of Schneider into the invention of Saffari/Bruzzese to provide greater interaction between the player and game as well as provide a player with anticipation of the second game during the operation of the first game as taught by Schneider (Col 2:24-33).

### ***Response to Arguments***

Applicant's arguments filed December 9<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant's arguments question the existence of "a unitary touch screen over both a video and non-video portions such that **both** the video and non-video portions

including the player selectable indicia selectable by the touch screen.” in the prior art of Saffari (Applicant’s Remarks Page 4). In response, Saffari is not relied upon for the teaching of the “unitary touch screen overlapping both a video and non-video portion” feature in the presented rejections as this feature is provided for through the inclusion of the Bruzzese reference (See rejection of Claim 1 presented above). In addition the selectable video portions and non-video portions are taught by Saffari et al reference. The correlating claim feature presented and the respective claim in its entirety have been previously rejected under USC 103 as unpatentable over Saffari et al in view of Bruzzese. The respective rejection(s) are maintained.

The Applicant challenges the incorporation of the Bruzzese reference as being a destructive combination with Saffari. On a first point Bruzzese teaches that though video machines utilize more technologically advanced components there is still a significant demand amongst players for older style spinning reel machines (Bruzzese Col 1:36-41). While this teaching promotes the use of the mechanical slot machine it fails to provide any destructive support for negating the incorporation of a video slot machine (MPEP 2143.01). While on a second and greater point the reference of Bruzzese is relied upon for a teaching to modify Saffari et al, not vise versa. In kind there is no alteration of the Bruzzese reference and hence no destructive alteration of the Bruzzese reference. The respective rejection(s) are maintained.

Applicant’s arguments directed to claims **4** and **10** are reliant on the above proposed and addressed destructive teaching and so fail in kind.

Applicant argues newly presented claim 11 as including language directed to the independent illumination of player selectable indicia, which the Applicant asserts as not being taught by Bridgeman (Applicant's Remarks Page 6). While the Applicant concedes that Bridgeman does teach the inclusion of a light circuit to "light up the buttons to indicate that the key activators 236 are ready to accept data Col 6, 11. 1-2.", they contend that the singular light circuit is not taught as being capable of independently illuminating the buttons. It is first noted that with regards to this feature Bridgeman more accurately reads "A drive circuit 226 controls the light circuits 238 that light up the buttons to indicate the key activators 236 are ready to accept input data" (Bridgeman Col 5:68-6:2). The noticeable distinction here, is rather then specifying a singular light circuit as suggested by Applicant, Bridgeman teaches a plurality of light circuits for illuminating the buttons. As such Bridgeman teaches the claimed feature of "second indicia being illuminated independently of the other second indicia". In further support of this Bridgeman indicates the purpose of the illumination as to "indicate the key activators 236 are ready to accept input data" along with the disclosed game process of Bridgeman that requires a sequential use of the buttons during game play (Figure 1,4, & Elm 56, 58, 60). It is accordingly unclear how the Applicant believes the illumination device of Bridgeman is a singular device and/or capable of illuminating all key activators when they are not operable in a given game state thereby seemly contradicting the stated purpose of the indicators as presented by Bridgeman.

Remaining arguments are addressed in the body of the rejections above and will not be repeated here.

***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



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TC3702